

REMARKS

This Response is submitted in reply to the Final Office Action dated May 29, 2009. Claims 1 to 4, 6 to 10, 14 to 18 and 20 to 25 have been amended. Claims 5 and 13 stand canceled. No new matter has been added by these amendments. Please charge deposit account 02-1818 for any fees which are due in connection with this Response.

The Office Action rejected Claims 1 to 4, 6, 8 to 12, 14 to 25 under 35 U.S.C. 103(a) as being unpatentable over WO 98/09259 to Bennett ("Bennett") in view of U.S. Patent No. 6,174,235 to Walker et al. ("Walker") and further in view of U.S. Patent No. 6,345,824 to Selitzky ("Selitzky").

Bennett discloses a gaming device that provides a tic-tac-toe based game. The gaming device includes a plurality of selectable zones and prizes associated with at least one of the zones. The gaming device enables the player and gaming device to alternate selecting unselected zones. Player selected zones are indicated with a player marker (e.g., an "X") and gaming device selected zones are indicated by a gaming device marker (e.g., an "O"). The gaming device displays a prize in a selected zone if a prize is associated with the selected zone. The player wins the game by selecting three zones in a straight line. If the player wins the game, the gaming device determines the player's award from the sum of any of the prizes in the player's selected zone multiplied by the number of units wagered. In certain versions of Bennett, the gaming device will associate some zones with a zero prize value.

The Abstract of Walker discloses:

[a]n electronic gaming device defines a set of all possible elements of a game. For example, in a slot machine-type game, the set of possible elements includes the symbols for cherries, bell, bar, orange, plum and seven. The gaming device further generates a set of location assignments for each of the elements, and assigns a location to each element in accordance with the set of location assignments. The player is presented with the locations and prompted to select one or more locations, depending on the type of game. The displayed locations to select are typically arranged in one or more rows of possible selections. Typically, each of the possible selections is hidden or obscured until

selected by the player. The player provides his selection(s), and at least one corresponding selection signal(s) are received by the gaming device. Each received selection signal indicates an element from the set of possible elements. The selected elements are displayed, either after each selection is made or after all selections are made. The gaming device evaluates an outcome of the game in accordance with the selected elements. Depending on the type of game, the outcome may or may not be based on the order in which the elements are selected. Since the player selects the elements, he is provided with an illusion of control over the outcome of the game.

Column 9, lines 18 to 26 of Walker disclose:

[r]eferring to FIG. 10, another embodiment of the present invention is described. Groups 300, 302 and 304 of possible selections are displayed, each set including all possible elements. The player selects at least one element from each of the groups 300, 302 and 304. For example, in a slot machine-type game, one symbol would be selected from each group, yielding three selected symbols. The outcome of the game would, in turn, be evaluated in accordance with the three selected symbols.

The Office Action relies on Walker for selecting a plurality of masked selections from one or more sets of selections.

The Abstract of Selitzky discloses:

[a] bonus method for a base casino card game, such as Blackjack or Baccarat, begins with the player making an ante wager and a first and second bonus wager. The player and dealer are each dealt a hand of cards, or electronic representations thereof. The player plays the player's hand to completion and is rewarded based on the player's first bonus wager if the player's hand includes a predetermined bonus combination. The values of the cards are then summed according to the rules of the base game and the player's ante wager is resolved by comparing a player's hand value with the hand value of the dealer and determining which hand is closest to a target value. Finally, the player's second bonus wager is resolved by rewarding the player if the player has won both the base game and the first bonus wager. If the player loses the base game or does not have a bonus combination, the player's second bonus wager is collected.

The Office Action relies on Selitzky for selecting at least one but not all of the awards from the plurality of different sets.

Amended independent claim 1 is directed to a gaming device including, amongst other elements, a processor in communication with the display device and the input device, the processor programmed, for each play of a game, to: (a) cause a plurality of masked selections to be displayed to a player by the display device; (b) associate a plurality of different values with the masked selections prior to the masked selections being picked by the player and without displaying which values are associated with which masked selections; (c) enable the player to pick a plurality of the masked selections for at least two predetermined sets, each of the predetermined sets being associated with a plurality of predetermined value displays; (d) for each of the predetermined sets, determine a plurality of the values for the predetermined value displays associated with the predetermined set, wherein the plurality of determined values are based on the values associated with the selections picked by the player for the predetermined set; (e) cause a display of each of the predetermined sets and the value of each predetermined value display associated with each predetermined set; (f) generate at least one award by selecting, for each one of the predetermined sets, at least one but not all of the plurality of values of the predetermined value displays, the selection occurs regardless of an amount of any of the values of the predetermined value displays associated with the predetermined set; and (g) provide the award to the player.

Applicant respectfully submits that neither Bennett, Walker or Selitzky individually, nor any gaming device resulting from the combination of Bennett, Walker and Selitzky anticipates or renders obvious a processor programmed, for each play of the game, to cause a display of each of the predetermined sets and the value of each predetermined value display associated with each predetermined set. Applicant submits that, in Bennett, a value is only displayed in a selectable zone that is selected by the player. That is, in Bennett, a value does not appear to be displayed in any unselected zones or any selectable zones that are selected by the gaming device. For example, as seen in Fig. 3 of Bennett (shown directly below), a value is not displayed in the selectable zone 53 that was selected by the gaming device.

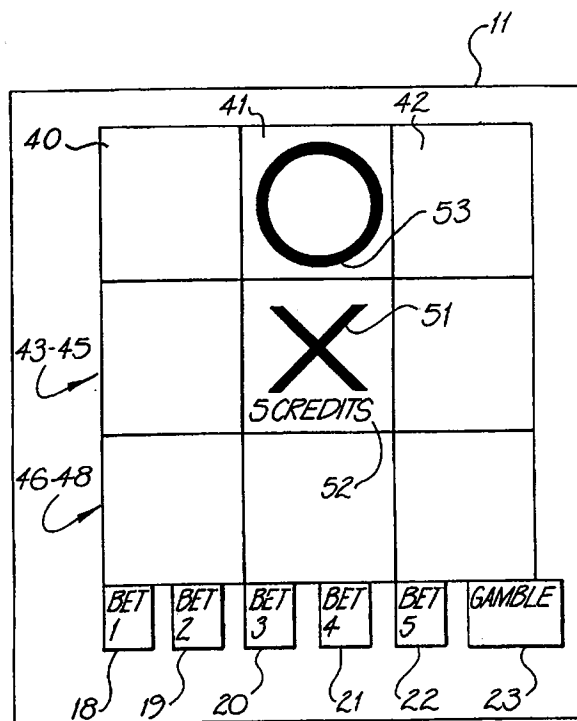


FIG. 3

Thus, Applicant submits that, in the gaming device resulting from the combination of Bennett, Walker and Selitzky, a value is not displayed for one or more of the selected zones in the matrix. On the other hand, the gaming device of amended independent Claim 1 includes, amongst other element, a processor programmed, for each play of a game, cause a display of each of the predetermined sets and the value of each predetermined value display associated with each predetermined set. Moreover, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gaming device resulting from the combination of Bennett, Walker and Selitzky to result in such a gaming device without reasonably being construed as improper hindsight reconstruction.

Page 3 of the Office Action stated that Bennett discloses:

[e]nable the player to pick a plurality of said masked selections for a designated number of predetermined sets (the Examiner interprets the entire game matrix of e.g., 3x3 selections to be the 'predetermined set).

Based on this interpretation, Applicant submits that neither Bennett, Walker or Selitzky individually, nor any gaming device resulting from the combination of Bennett, Walker and Selitzky anticipates or renders obvious a processor programmed, for each play of a game, for each of the predetermined sets, determine a plurality of the values for the predetermined value displays associated with the predetermined set, wherein the plurality of determined values are based on the values associated with the selections picked by the player for the predetermined set. That is, in the gaming device of amended independent Claim 1, each predetermined value display in each predetermined set is associated with a value based on the values associated with the selections picked by the player. On the other hand, if the entire 3x3 matrix of Bennett is interpreted as the predetermined set of amended independent Claim 1, because the gaming device resulting from the combination of Bennett, Walker and Selitzky selects a plurality of the selectable zones in the matrix, each of the selectable zones are not selected by the player. For example, page 4, lines 13 to 15 of Bennett disclose that:

[t]he machine will then select an image element (53 in Figure 3) and then invite the player to select an element, until the game has been won by the player or the machine or the game has become unwinnable. (emphasis added)

Thus, Applicant submits that, in the gaming device resulting from the combination of Bennett, Walker and Selitzky, a plurality of the selected zones in the matrix are not selected by the player. On the other hand, the gaming device of amended independent Claim 1 includes, amongst other elements, a processor programmed, for each play of a game, for each of the predetermined sets, determine a plurality of the values for the predetermined value displays in the predetermined set, wherein the plurality of determined values of the predetermined value displays in the predetermined set are based on the determined values associated with the masked selections picked by the player for the predetermined set. Moreover, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gaming device resulting from the combination of Bennett, Walker and Selitzky to result in such a gaming device without reasonably being construed as improper hindsight reconstruction.

For at least these reasons, Applicant submits that amended independent claim 1 is patentably distinguished over Bennett, Walker and Selitzky and is in condition for allowance.

Claims 2 to 4 depend directly from amended independent claim 1 and are also allowable for the reasons given with respect to amended independent claim 1 and because of the additional features recited in these claims.

The gaming devices of amended independent claims 6, 8, 9, 14, 15, 16, 18, 21, 23 and 25 each include certain similar elements to amended independent claim 1. For reasons similar to those discussed above with respect to amended independent claim 1, amended independent claims 6, 8, 9, 14, 15, 16, 18, 21, 23 and 25 (and dependent claims 7, 10 to 12, 17, 19 to 20, 22 and 24 respectively) are each patentably distinguished over Bennett, Walker and Selitzky and are in condition for allowance.

Page 6 of the Office Action stated that:

[t]he combination of Bennett and Walker teaches the invention as described above, but lacks in explicitly stating that each of the associated values is greater than zero. Such a limitation lacks criticality in the invention, as evidenced by the fact that all prior and numerous existing claims make no mention of the particular values to be assigned to each selection.

The Office Action concluded that a gaming device wherein the associated values are each greater than zero is therefore an obvious matter of design choice and does not change the operation of Bennett.

Applicant respectfully disagrees and reiterates the arguments previously submitted in the Response to Office Action of December 22, 2008 that a gaming device that includes: a processor programmed, for each play of a game, to: display a plurality of masked selections, wherein the masked selections are associated with a plurality of values prior to the masked selections being picked by the player and without displaying which values are associated with which masked selections, and wherein the associated values are each greater than zero is substantially more than a simple design choice.

Based on the MPEP guidelines for asserting design choice, it is not appropriate for the Office Action to assert that associating different values with selections in the gaming device of amended independent claim 21 is a design choice if the claimed invention functions differently from the prior art. For example, the MPEP §2144.04(I) states that a feature that is merely an aesthetic design change does not distinguish from prior art if the claimed features relate to ornamentation and not to function (citing In re Seid, 161 F.2d 229 (CCPA 1947)). The MPEP §2144.04(VI)(C) also states that a rearrangement of parts may be an obvious matter of design choice where moving a feature of an invention would not have modified the operation of the device (citing In re Japikse, 181 F.2d 1019 (CCPA 1950)).

Associating values greater than zero with each selection is not an aesthetic or an ornamental change to the gaming device resulting from the combination of Bennett, Walker and Selitzky. Moreover, associating values greater than zero with each selection is not a rearrangement of the parts of the gaming device resulting from the combination of Bennett, Walker and Selitzky that would not modify the operation of Bennett in view of Walker and Selitzky. Rather, because such elements pertain to the functionality of how the gaming device determines the player's award, such elements do not represent ornamentation. Thus, the Office Action's acknowledgement that the gaming device resulting from the combination of Bennett, Walker and Selitzky does not disclose a processor programmed, for each play of a game, to: display a plurality of masked selections, wherein the masked selections are associated with a plurality of values prior to the masked selections being picked by the player and without displaying which values are associated with which masked selections, and wherein the associated values are each greater than zero prevents any finding or conclusions that such functional differences are merely a design choice under the MPEP guidelines. Accordingly, the Office Action's conclusions of obvious design choice cannot properly form the basis of this rejection.

Moreover, Applicant submits that it is improper for the Office Action to contend that prior art references do not disclose certain claimed elements and then simply state that these claimed elements are a simple design variation. Without providing any

reference which discloses these claimed elements, any conclusions that such claimed elements are a simple design choice is impermissible. As stated in In re Chu, 66 F.3d 292, the finding of In re Gal, 980 F.2d 717 is that 'obvious design choice' is precluded where the claimed structure and the function it performs are different from the prior art.

The Office Action rejected claim 7 under 35 U.S.C. 103(a) as being unpatentable over Bennett in view of Walker et al. and further in view of Selitzky and yet in further view of Admitted Prior Art.

Specifically, page 7 of the Office Action stated that:

[t]he combined teaching of Bennett, Walker, and Selitzky lacks in explicitly teaching that the display device displays the selections and reveals values associated with the selections that are not picked by the player. The Examiner, in a previous rejection, took Official Notice that it was notoriously well known in the art at the time of invention to display the non-chosen values, in addition to the chosen values. One of ordinary skill in the art at the time of invention would have been motivated to do so in order to indicate to the player what he or she could have selected. Applicant failed to adequately challenge the Examiner's Official Notice and it is now considered Admitted Prior Art.

Applicant submits that regardless of whether it was well known in the art at the time to display the non-chosen values, in addition to the chosen values, neither Bennett, Walker, Selitzky or the Admitted Prior Art individually, nor the gaming device resulting from the combination of Bennett, Walker, Selitzky and the Admitted Prior Art anticipate or render obvious a processor programmed, for each play of a game, to: (d) for each of the predetermined sets, determine a plurality of the values for the predetermined value displays associated with the predetermined set, wherein the plurality of determined values are based on the values associated with the selections picked by the player for the predetermined set; (e) cause a display of each of the predetermined sets and the value of each predetermined value display associated with each predetermined set. On the other hand, Claim 7 includes, amongst other elements, a processor programmed, for each play of a game, to: (d) for each of the predetermined sets, determine a plurality of the values for the predetermined value displays associated with the predetermined set, wherein the plurality of determined values are based on the values associated with the selections picked by the player for the predetermined set; (e) cause a display of

each of the predetermined sets and the value of each predetermined value display associated with each predetermined set. Moreover, it would not have been obvious to one of ordinary skill in the art at the time the invention was made to modify the gaming device resulting from the combination of Bennett, Walker, Selitzky and the Admitted Prior Art to result in such a gaming device without reasonably being construed as improper hindsight reconstruction.

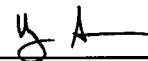
Accordingly, for this reason and the reasoning provided with respect to independent claim 6, Applicant respectfully submits that claim 7 is patentably distinguished Bennett, Walker, Selitzky and the Admitted Prior Art and is in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicant respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

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